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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,717	07/28/2003	Douglas P. Gethmann	06005/39056	6718
4743	7590	05/24/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			BASTIANELLI, JOHN	
		ART UNIT	PAPER NUMBER	
		3751		

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/628,717	GETHMANN, DOUGLAS P.
	<b>Examiner</b> John Bastianelli	<b>Art Unit</b> 3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 April 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.  
 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-14 and 21-26 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 28 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 7-11, 21, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Chou US 4,964,432.

Chou discloses a valve having a valve housing 12 having an inlet and an outlet 16, and a chamber therebetween, a valve stem 46 slidably mounted in the housing; a valve plug 62 connected to the valve stem and movable within the chamber; a packing box (inside housing 32 on the outside of packing 42 and packing follower 40) provided in the valve housing around the valve stem; packing 42 disposed in the packing box around the sliding stem; and a sleeve 76 or substantially cylindrical housing 84 is mounted to the valve stem disposed between the valve plug and the packing box, the sleeve having a diameter less than a diameter of the packing box (Fig. 1). The sleeve 76 has first and second halves 78. A snap lock 84 is frictionally fit around the sleeve 76. The valve stem is connected to a valve actuator 48. The sleeve is shown to be manufactured from metal (Fig. 1 hatching).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 and 22, and alternatively 1 and 21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chou US 4,964,432 in view of Seeley US 3,262,673.

Chou lacks the device's housing 76 being substantially cylindrical. Seeley discloses a cylindrical housing 19 and 20. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the housing substantially cylindrical, since it has been held that a change in the shape of the element involves only routine skill in the art. *In re Dailey*, 149 USPQ 47 (CCPA 1966) and this would provide cheaper manufacturing costs as it would be simpler to manufacture.

5. Claim 3 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chou US 4,964,432 in view of Seeley US 3,262,673 and further in view of Hinrichs US 4,270,730.

Chou lacks the retainer sleeve having a longitudinal gap. Hinrichs discloses a snap ring 70 with a longitudinal gap. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the snap ring of Hinrichs in place of the retainer of Chou in order to more effectively hold the housing onto the valve stem as it is more adjustable due to the longitudinal gap.

6. Claims 5-6, 12-14, 25 and 26 and alternatively claims 4 and 11, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chou US 4,964,432 in view of Pittman US 5,788,216. Chou is silent as to what material the sleeve is made. Pittman discloses the materials metal, plastic, composite material, or tetrafluoroethylene. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the sleeve out of metal,

plastic, composite material, or tetrafluoroethylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, USPQ 416 (CCPA 1960).

### ***Response to Arguments***

7. Applicant's arguments filed April 29, 2005 have been fully considered but they are not persuasive.

8. Regarding applicant's argument that the sleeve or removal device is not disposed between the valve plug and the packing box, this is incorrect as the sleeve or removal device removably secured to the valve stem of Chou is between the packing box and the bottom of the valve plug and therefore meets the claims as written.

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the motivation to do so was provided by the examiner in the 103 rejections above.

10. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Regarding the argument that

Seeley, Hinrichs and Pittman fail to disclose the cylindrical housing or sleeve between the valve member and a packing box, this is irrelevant as the examiner relies on Chou for this feature.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Bastianelli whose telephone number is (571) 272-4921. The examiner can normally be reached on M-F (9:00-6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John Bastianelli  
Primary Examiner  
Art Unit 3751



JB

May 20, 2005